II. Obviousness-Type Double Patenting Rejection

The Office has provisionally rejected claims 53-68 under the judicially created doctrine of obviousness-type double patenting over the claims 1-48 of U.S. Patent Application 09/863,411.

To obviate this rejection, Applicants have filed herewith a Terminal Disclaimer in accordance with M.P.E.P. § 804.02. Thus, Applicants request that the rejection be withdrawn.

III. Rejection Under 35 U.S.C. § 103(a)

The Office has rejected claims 1-4 and 6-68 under § 103(a) over U.S. Patent No. 5,993,491 to Lim et al. ("Lim") in view of WO 99/17730 (U.S. Patent No. 6,228,129)[1] to de la Mettrie et al. ("de la Mettrie") and U.S. Patent No. 5,865,853 to Schmitt et al. ("Schmitt"). Applicants respectfully traverse this rejection for the reasons set forth below.

A. There is no evidence of a motivation or suggestion to combine Lim, Mettrie, and Schmitt, which teach different dye systems.

The Federal Circuit has held that there must be a "clear and particular" suggestion in the prior art to combine the teachings of cited references as proposed by the Examiner. *In re Dembiczak,* 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the

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[1] Applicants note that U.S. Patent No. 6,228,129, which is refered to in this response, is an English equivalent to WO 99/17730.

teaching or motivation to combine prior art references." *Id.* Further, the Office must not only "assure that the requisite findings [of motivation] are made, based on the evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Sang-Su Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) (emphasis added). In the present case, the Office has not made any such explanations, but rather makes conclusory statements based on improper hindsight-based reconstruction of the present invention.

For instance, the Office asserts that "[t]he instant claims differ from [Lim] by reciting a hair dyeing composition comprising dyeing ingredients such as enzymatic oxidizing system as oxidizing agents, cationic direct dyes and nitrobenzene direct dyes." Present Office Action at page 4, lines 17-19. Then, in an effort to cure these deficiencies, the Office relies on de la Mettrie and Schmitt, as analogous art, merely on the basis that their disclosures "would be similarly useful and applicable to the analogous composition taught by Lim." *Id.* at page 4, line 20 - page 5, line 10. Applicants respectfully disagree, and submit that the Office's analysis is misplaced.

With regard to Lim, the invention disclosed therein provides oxidative hair dye compositions and methods for the "oxidative coloration of hair comprising compounds of the class of 1-4-(aminophenyl)-2-pyrrolidinemethanols . . . as primary intermediates in compositions comprising such primary dye intermediates as well as coupling agents, oxidizing agents and other adjuvant substances." Col. 2, lines 33-40. Lim, however, does not mention or even suggest the incorporation of the nitrobenzene or cationic direct dye compounds of the present invention. Moreover, the Office has not shown that there would be any desire to modify the invention of Lim. *See* M.P.E.P. § 2143.01,

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citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990) ("The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."). Further, as taught by Lim, the compositions and methods of the invention lead to the preparation of "stable oxidative hair dyes that result in long-lasting and true colors which are different from colors produced by similar primary intermediates." Col. 1, lines 8-11. As such, Applicants respectfully submit that there would not be a desire to modify Lim, and thus the rejection should be withdrawn for this reason alone.

The secondary references do not remedy the deficiencies of Lim. With regard to de la Mettrie, the reference relates to oxidation dyeing with at least one oxidation base, at least one cationic direct dye, and at least one enzyme as an oxidizing agent. *See* col. 1, lines 5-12. Here again, the combination of the specific components of the invention leads to optimum results. Specifically, the combination results in dyes "leading to intense and chromatic colorations, without giving rise to any significant degradation of the keratin fibres, and which are relatively unselective and show good resistance to the various attacking factors which hair may be subjected." *See* col. 2, lines 7-15. At best, de la Mettrie discloses many types of cationic direct dyes that may be used in its compositions, but it does not teach or suggest combining any of the compounds with 1-4-(aminophenyl)-2-pyrrolidinemethanols or with any pyrrolidines. *See* col. 2, lines 7-15. Thus, the rejection should be withdrawn for this reason as well.

Applicants also point out that de la Mettrie discloses that the nature of the oxidation base used in its compositions is <u>not</u> even a critical factor. *See* col. 3, lines 9-13. For example, *inter alia*, de la Mettrie discloses that para-phenylenediamines may

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be used as oxidation bases. *See id.* By contrast, the present invention demonstrates that the selection of the oxidation base is essential to the claimed invention. For instance, the example on pages 81-83 base of the instant specification demonstrates that the selection of an addition acid of 1-4-(aminophenyl)-2-pyrrolidine of formula (I), instead of a para-phenylenediamine, as oxidation bases, results in a hair dye that is more intense in color.

With regard to Schmitt, the reference exclusively relates to a composition for dyeing keratin fibers based on vegetable dyes and direct-dyeing dye compounds, i.e., at least one powdery vegetable dye ingredient, at least one oil, and at least one direct-dyeing dye compound, and not oxidation dyeing. *See* col. 2, lines 19-26. At best, Schmitt recites a laundry list of direct dye compounds, among them nitrobenzene compounds, but there is there is no suggestion to use any of these compounds in an oxidation dyeing composition. *See* col. 2, line 64 – col. 4, line 19. In fact, Schmitt points out that the sole aim of the invention is to provide a vegetable dye, which has dust-free, good miscibility, and good application properties. *See* col. 2, lines 7-13. These properties can only be obtained by a suspension, emulsion, or dispersion-like vegetable dye composition. *Id.* at lines 14-18. As such, Schmitt teaches away from combining its ingredients with an oxidation dye composition. *See* M.P.E.P. § 2141.02 (a "prior art reference as a whole" must be considered) and M.P.E.P. § 2145(X)(D)(1) (a "prior art reference that 'teaches away' from the claimed invention is a significant factor to be considered in determining obviousness"). Accordingly, the rejection should be withdrawn for this additional reason.

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Thus, there is no evidence in the record that supports the Office's proposal to selectively pluck teachings from de la Mettrie and Schmitt to supplement or modify the dye composition of Lim. *See In re Zurko*, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (finding that unless there is "substantial evidence" found in the record to support the factual determinations central to the issue of patentability, the rejection is improper and should be withdrawn). As there is no suggestion, other than Applicants disclosure, to modify Lim with de la Mettrie and Schmitt, the prima facie case of obviousness is improper. Accordingly, the rejection should be withdrawn for this additional reason.

IV. Allowable Subject Matter

Applicants thank the Office for indicating that claim 5 contains allowable subject matter. *See* Present Office Action at page 5, lines 12-14.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

The Examiner is invited to contact Bryant L. Young at (202) 408-4328, if any matter may be resolved by a telephone conference.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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